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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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IBM CORPORATION (RHF) C/O ROBERT H. FRANTZ P. O. BOX 23324 OKLAHOMA CITY, OK 73123			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,113

Applicant(s)

GUSLER ET AL.

Examiner

Yogesh C. Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/28/2006 (Appeal Brief).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on 3/28/2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Response to Arguments

2. In the Appeal Brief, appellant argues at page 5 - 9 that Odigo does not teach or disclose the claim limitation of "otherwise disassociated". The examiner respectfully disagrees.

First and of note, the Appellant arguments focus only on the meaning of the phrase "otherwise disassociated" and specifically the meaning of the word

"disassociated". In that regard and as noted in the Final Rejection at page 9 and 10, the Appellant did not specifically define nor even use the word "disassociated" in the their specification. In that regard and in a reasonably broad interpretation of the word "disassociated" and as defined by Merriam-Webster's Dictionary - "as detached from association", Odigo would teach that one online user/shopper is "detached" from another when the new friend/user/shopper is not aware of nor even know the other user/shopper previously - or is even that the other user/shopper is online. Moreover in the Applicant's specification examples, AOL buddies can add new friends to their list. In order for these two "new" friends to communicate via AOL Instant messaging with the others - they must have the same software (i.e. AOL Instant Messaging) to communicate and thereby are associated in the AOL Instant Messaging community (see at least Para 0031 and Para 0056). In this case, Odigo members/users/shoppers can introduce themselves to a fellow Odigo user/shoppers, who they are not currently associated with - since new user/shopper/friend does not know the other as well as the "new" user/shopper is not even aware that the other user/shopper is online. For example, Odigo would teach one of ordinary skill the capability to through "People-Finder" new friends and introduce oneself to another user/new friend/shopper- that currently does not know them or is even aware that they are on the internet (Page 1, 3-5 and 11-13). Thereby and prior to the introduction, the new users/shopper/friend is "detached" and "otherwise disassociated" from the other user/shopper.

Second, the independent claims are excessively broad and vague especially in light of the word "disassociated". While the Appellant attempts to redefine his meaning

Art Unit: 3625

of the phrase "otherwise disassociated" and specifically the word "disassociated" by comparing to the word associated at pages 6 and 7, the specification as originally filed does not contain any disclosure or explanation of the phrase. Moreover, the Appellant's and specification does not even contain the word "disassociated". Thereby, it forces one of ordinary skill in the art to simply speculate exactly what "disassociated" and thereby the phrase "otherwise disassociated" means, which makes determining the metes and bounds of the claim almost impossible. In this case and as noted above, an interpretation regarding the word "disassociated" and thereby the phrase "otherwise disassociated" was interpreted and this interpretation was - that the shoppers were disassociated with each other until an one on line shopper notifies the other of their presence (Odigo pages marked 5, 7 and 9). Turning to the claims, it is noted that online shopper must also be "using" a "common" virtual shopping resource and thereby the online shoppers are "associated" (i.e. the opposite of disassociated) but somehow and left to the reader's speculation and wonderment is exactly how they are "otherwise disassociated". While the Appellant at page 8 attempts to have it both ways - whereby the online shoppers are "associated" at a common virtual shopping resource but are "otherwise disassociated", this tortured explanation by the Appellant is contradictory (i.e. associated but not associated) and thereby adds to the confusion and speculation of interpreting the phrase "otherwise disassociated" and especially the word "disassociated". Furthermore and in contrast and contradicts Appellant's arguments, the specification at Para 0056, last sentence states that "one set of criteria maybe that the detected shopper must already be on the shopper's buddy list", which clearly indicies

Art Unit: 3625

that these individuals are associated previously - the opposite of "disassociated".

Therefore and as noted in the Final Rejection, Odigo teaches a method and system for providing enhanced online shopping experiences to online shoppers for automatic association of two or more online shoppers, said method comprising the steps of: searching a list of concurrently online shoppers according to a set of search criteria, said shoppers each contemporarily being a user of a common virtual shopping resource, said shoppers being otherwise disassociated with each other (see at least pages 1 - 8 and 11 - 13); notifying a first online shopper that at least one other concurrently online shopper meets said search criteria; and automatically associating said first online shopper with said one or more concurrently online shoppers meeting said criteria (see at least pages 1 - 2 and 7 - 9).

Appellant argues at page 9 and 10 of the brief that the public was not in possession of Invention and that Surfing and Archive do not provide enabling disclosures. With respect to the public being in possession of the Odigo, the reference clearly teaches that the public as well as potential partner(s) can download the software and use Odigo software. For example, the reference teaches that the software had been downloaded and evaluated (see at least pages 1 - 2). Moreover, the Odigo teaches that Partner's such as "StarMedia Network" has implemented and is using Odigo software (page 5) and thereby teaches that Odigo was clearly in Public use with a key partner. With respect to providing an enabling disclosure, it is noted that the reference as whole teaches that the Odigo software is clearly enabled - since it is in use by partners as well as individual user's and the functions of the software are also

Art Unit: 3625

disclosed. In addition and as noted in the decision of *Fonar Corp v. General Electric Co.*, 41 USPQ2d 1801, 1805 - "As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed.... [F]low charts or source code listings are not a requirement for adequately disclosing the functions of software."

Appellant argues at page 9 that the combination of Surfing and Archive into a single reference under 35 USC 102 is improper. While the Appellant asserts that the combination of the Surfing and Archive is improper for a 102 rejection, the Appellant does not cite any reference such as the MPEP or Court cases, which clearly detail that combining NPL references is not proper. In this case and as noted by the MPEP (2131.01), Multiple references can be used for a 102 Rejection, whereby the primary reference "Surfing" contains an "enabled disclosure", which "Archive" discloses.

In view of the foregoing, the rejection of claims 1, 3, 4, 8, 9, 10, 12, 13, 17, 18, 19, 21, 22, 26 and 27 under 35 U.S.C. 102(b) as being in public use as evidenced by "Surfing; [Cook/Dupage/Fox Valley/Lake/McHenry Edition]; Daily Herald; Arlington Heights, Ill; Dec 6, 1999 and [Odigo.com](#) web pages of May 10, 2000 captured via the WayBackMachine (archive.org) and hereafter collectively referred to as "Odigo", is sustainable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 4, 8, 9, 10, 12, 13, 17, 18, 19, 21, 22, 26 and 27 are rejected under 35 U.S.C. 102(b) as being in public use as evidenced by "Surfing; [Cook/Dupage/Fox Valley/Lake/McHenry Edition]; Daily Herald; Arlington Heights, Ill; Dec 6, 1999 and Odigo.com web pages of May 10, 2000 captured via the WayBackMachine (archieve.org) and hereafter collectively referred to as "Odigo".

Please note that each of the NPL documents pre-date the filing of the applicant's invention by 1 year.

Regarding Claim 1 and related claims 10 and 19 (previously amended), Odigo teaches a method and system for providing enhanced online shopping experiences to online shoppers for automatic association of two or more online shoppers, said method comprising the steps of: searching a list of concurrently online shoppers according to a set of search criteria, said shoppers each contemporarily being a user of a common virtual shopping resource, said shoppers being otherwise disassociated with each other (see at least pages 1 - 8 and 11 -13); notifying a first online shopper that at least one

Art Unit: 3625

other concurrently online shopper meets said search criteria; a associating said first online shopper with said one or more concurrently online shoppers meeting said criteria (see at least pages 1 - 2 and 7 - 9).

Regarding Claim 3 and related claims 12 and 21 (original), Odigo teaches a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper name criteria (Page 5 and 9).

Regarding claim 4 and related claims 13 and 22, Odigo teaches a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper position criteria (Page 7).

Regarding claim 8 and related claims 17 and 26, Odigo teaches a method wherein said step of automatically associating said first online shopper with said one or more concurrently online shoppers comprises establishing a communications session between said online shoppers (Pages 7 and 11).

Regarding claim 9 and related claims 18 and 27, Odigo teaches a method wherein said step of establishing a communications session between said online shoppers further comprises making a record of said communications session (pages 7 and 11). Please note that Odigo does not specifically disclose recording the communication

Art Unit: 3625

session. However, it is old and well known that these chat/communications sessions can and are saved in a database, which is effectively a recording. In this manner, the individuals will be able at a later to review their online chat sessions as necessary.

4. Claims 1, 3, 4, 8, 9, 10, 12, 13, 17, 18, 19, 21, 22, 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Odigo.

Regarding Claim 1 and related claims 10 and 19 (previously amended), Odigo teaches a method and system for providing enhanced online shopping experiences to online shoppers for automatic association of two or more online shoppers, said method comprising the steps of: searching a list of concurrently online shoppers according to a set of search criteria, said shoppers each contemporarily being a user of a common virtual shopping resource, said shoppers being otherwise disassociated with each other (see at least pages 1 - 8 and 11 -13); notifying a first online shopper that at least one other concurrently online shopper meets said search criteria; a associating said first online shopper with said one or more concurrently online shoppers meeting said criteria (see at least pages 1 - 2 and 7 - 9).

Regarding Claim 3 and related claims 12 and 21 (original), Odigo teaches a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper name criteria (Page 5 and 9).

Regarding claim 4 and related claims 13 and 22, Odigo teaches a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper position criteria (Page 7).

Regarding claim 8 and related claims 17 and 26, Odigo teaches a method wherein said step of automatically associating said first online shopper with said one or more concurrently online shoppers comprises establishing a communications session between said online shoppers (Pages 7 and 11).

Regarding claim 9 and related claims 18 and 27, Odigo teaches a method wherein said step of establishing a communications session between said online shoppers further comprises making a record of said communications session (pages 7 and 11). Please note that Odigo does not specifically disclose recording the communication session. However, it is old and well known that these chat/communications sessions can and are saved in a database, which is effectively a recording. In this manner, the individuals will be able at a later to review their online chat sessions as necessary.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3625

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 5-6, 11, 14-15, 20 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odigo as applied to claims 1 and 19 above, and further in view of Tang et al.(US 6,349,327), hereinafter referred as Tang.

Regarding claim 2 and related claims 11 and 20, Odigo discloses and teaches substantially the applicant's invention, as analyzed above with respect to claims 1, 10 and 19. However, Odigo does not specifically disclose and teach a method and system wherein said step of notifying a first online shopper comprises providing a buddy position indicator on a graphical map of an online shopping mall.

It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Tang in the analogous art discloses a computer-based mechanism used in searching a list of concurrently online workers, who are unaware of each other, according to a set of search criteria [that is a task proximity relationship occurs among these workers based on any of three distinct factors, that is (i) the application the worker is currently using, (ii) the data the worker is accessing or manipulating, and (3) the time at which the worker is accessing or manipulating] . The same computer-mechanism notifies a first work member that at least one other concurrently online worker [both the workers being unaware of each other as regards to their task proximity relationship] meets said search criteria, that is

Art Unit: 3625

of task proximity and discloses that the step of notifying a first online shopper comprises providing a buddy position indicator graphically on the computer screen if that buddy is working on the same data/manipulating the same data or working on the same application at the same time (see Fig.1, col.2, lines 38-49, col.3, line 33-col.6, line 5). Tang's art is reasonably pertinent to the particular problem with which the applicant was concerned, that is notifying a worker a buddy position graphically on a graphic screen while working on the same task [notifying a shopper in the applicant's invention of a buddy position also shopping in proximity but unaware of each other] and these workers are unaware of each other's presence [disassociated from each other as claimed in the applicant's invention]. In view of Tang, it would have been obvious to one of ordinary skill in the art a the tie of the invention to have provided the method and system of Odigo with the method and system of Tang to have enabled a method and system wherein said step of notifying a first online shopper comprises providing a buddy position indicator graphically/on a graphical map of an online shopping mall because, as explicitly disclosed in Tang (see at least Tang, col.3, lines 47-55), it would enable the shoppers to become aware of each other's proximity, which otherwise on Internet would not be possible, and would facilitate spontaneous interaction such as found in physical environments like shopping malls leading to helping or support each other in their respective shopping tasks.

Regarding claims 5-6 and related claims 14-15 and 23-24, Odigo discloses and teaches substantially the applicant's invention, as analyzed above with respect to claims 1,

Art Unit: 3625

10 and 19. However, Odigo does not specifically disclose and teach a method and system wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper interest term criteria or a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper position proximity criteria.

Tang in the analogous art, as analyzed for claims 2, 11 and 20 above teaches (see Fig.1, col.2, lines 38-49, col.3, line 33-col.6, line 5) that step of searching a list of concurrently online shoppers [workers in Tang] according to a set of search criteria [criteria of task proximity in Tang] comprises searching by an online shopper interest term criteria [the worker working/manipulating same data/application at the same time] or a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper position proximity criteria [task proximity in Tang]. In view of Tang, it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Odigo with the method and system of Tang to have enabled a method and system wherein said step of said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper interest term criteria or a method wherein said step of searching a list of concurrently online shoppers according to a set of search criteria comprises searching by an online shopper position proximity criteria because it would help to notify the shoppers of each other's proximity, which otherwise on Internet would not be possible,

Art Unit: 3625

and would facilitate spontaneous interaction such as found in physical environments like shopping malls leading to helping or support each other in their respective shopping tasks.

7. Claims 7, 16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odigo as applied to claims 1, 10 and 19 above, and further in view of Kenney (US Patent 6,381,583).

Regarding claim 7 and related claims 16 and 25, Odigo discloses and teaches substantially the applicant's invention, as analyzed above with respect to claims 1, 10 and 19. However, Odigo does not specifically disclose and teach a method and system wherein said step of automatically associating said first online shopper with said one or more concurrently online shoppers comprises setting position coordinates for both shoppers to equivalent values. On the other hand in the same area of interactive electronic shopping online method and systems and regarding claim, 7 and related claims 16 and 25, Kenney teaches a method and system setting position coordinates for shoppers to equivalent values (see at least col.2, lines 40-65, col.8, lines 17-57, col.9, lines 34-56 and col.10, lines 37-52. Kenney's invention, in the same field as that of Odigo, discloses shoppers carrying out online interactive electronic shopping and while traveling/navigating through a shopping area, such as a store, the system continuously keeps a track of the location of a shoppers and their movements by tracking their cursors. Computer programming is used to define or to set position coordinates for the shoppers with preset spatial parameters that define the range of x-

y-z coordinates to be shown at any given cursor location, which is indicative of a shopper's location in the shopping area). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided Odigo with the a method and system of Kenney to have enabled a method and system wherein said step of automatically associating said first online shopper with said one or more concurrently online shoppers comprises setting position coordinates for both shoppers to equivalent values because, as explicitly disclosed and discussed in Kenney (see at least col.2, lines 40-65, col.8, lines 17-57, col.9, lines 34-56 and col.10, lines 37-52) it would enable Odigo's method and system would help to identify the position of shoppers precisely in a shopping area which would further enhance the Odigo's method and system in searching and identifying shoppers shopping in the same area and making them aware of each other for the obvious reasons of providing them an opportunity to interact, which otherwise they could not have done. The advantages of interacting while shopping at the same place at the same time are already discussed while analyzing claims 2, 11 and 20.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,587,835 to Treyz discloses a method and system for helping a shopper to obtain directory information of a shopping mall via a hand-held mobile communication device by providing a graphical map of a virtual shopping mall, said map

Art Unit: 3625

having a coordinate system associated with positions within the shopping mall and assigning a customer position having a set of coordinates within the shopping mall (see at least Abstract, col.37, lines 11-20 and Fig.45).

(ii) US Patent 6,388,688 to Schileru-Key discloses a computerized method and system comprising: presenting information regarding products and suppliers to users via a browser visiting a cybermall (interactive navigation and exploration of spatial environments, both real and visual, col. 1, lines 55-57, visual shopping mall and visual stores, col. 12, lines 60-61. The cybermall comprising a collection of cyber stores (visual shopping mall and virtual stores, col. 12, lines 60-61), displaying a visual map of a cybermall, the map having a coordinate system associated with positions within the cybermall (a map view window is initialized with intersections, paths', col. 5, lines 15-22', Figure 1 ref. no. 106 map; Figure 13 and Figure 15), assigning a user an initial position having a set of coordinates within the cybermall (main view window 1110 shows the image frame associated with the starting intersection, as well as any path choices 1130 col. 5, lines 19-21, when the user selects a choice, the path represented by that choice and any destination intersections are highlighted in map view window, col. 5, lines 23-26), presenting to the user at least one vector graphics multimedia object to the user according to the initial position coordinates, the multimedia objects being associated with one or more cyber stores such that an apparent relationship to an existent physical merchant facility is provided (col. 5, lines 23-35., col. 8, lines 36- 50, & Figure 12), updating the initial position to a subsequent position responsive to a position change command from the user (when the user selects a choice, the path

Art Unit: 3625


represented by that choice and any destination intersections are highlighted in map view window. The program plays the image sequence associated with the path, col. 5, lines 23-27).

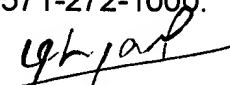
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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